

Amendments to the Drawings

The attached sheets of drawings include changes to FIGS. 4-8 and a new FIG. 10. The sheets including FIGS. 4-8 replace the original sheets including FIGS. 4-8. FIG. 4 has been changed to FIG. 4A and FIG. 4B to show an uncovered hatch and a covered hatch, while FIGS. 5-8 have been changed to more clearly label the figures and better define the lines and numbers. New FIG. 10 shows the embodiment of a hollow lip holding the strap. No new matter has been added.

Support for the amendments presented in FIGS. 4A, 4B, 5, 6, 7, 8, and 10 is found in the specification and the claims.

Attachments: Six replacement sheets
One new sheet

REMARKS

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 1-34 are pending. In this Amendment, claims 20-21, 23-24, and 29 are canceled; claims 4-5, 7-12, and 14-19 are withdrawn; claims 1, 22, 25-26, and 31 are amended; and claims 35-39 are added. No new matter is added.

Support for the amendment to claim 1 is found in the originally filed claims 20-21, in FIGS. 4 and 5, as well as elsewhere in the originally filed specification, drawings, and claims. Support for amended claim 31 is found at page 7, lines 3-4 of the specification as well as elsewhere in the originally filed specification, drawings, and claims. Amendments to claims 22, 25, and 26 are merely to change dependency. Support for new claims 35-39 is found in originally filed claims 6, 20-22, and 25-26 as well as elsewhere in the originally filed specification, drawings and claims.

Applicant has submitted replacement drawings in compliance with 37 C.F.R. §§ 1.83-1.85, as requested by the Examiner.

Claims 26-34 are rejected under 35 U.S.C. § 112, first paragraph. While Applicant believes the specification as originally filed is enabling, the specification has been amended to insert a new paragraph at page 7, line 15 (before the last paragraph) to provide a more clearly enabling description of how the components of the invention are installed and used together, in compliance with the requirements of 35 U.S.C. § 112, first paragraph. No new matter has been added to the application. All the information contained within the new paragraph can be found in the originally filed description, claims, and/or drawings. Accordingly, Applicant believes that the specification is now even more enabling and respectfully requests that this rejection be withdrawn.

Further, Applicants thanks the Examiner for indicating the need for the inclusion of priority data on the first page of the application. Applicant has amended the specification accordingly.

Claims 1-3, 6, 13, and 20-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,533,044 to Ban in view of U.S. Patent No. 5,295,508 to Metzger. This rejection is respectfully traversed with respect to the claims as currently presented.

Claim 1 as amended claims a paint container sealing lid including a base with a hatch and lip and strap for holding the lip against a container. Further, the hatch contains slots for holding tools and the hatch is large enough to receive the entire tool. The Office Action states that Ban discloses substantially all of the elements of the present invention, but Applicant respectfully disagrees. Ban discloses only a paint storage container having a cover with “at least one small opening” (see column 2, line 52 and claim 1, section b) for receiving the handle of a paint applicator. Metzger is cited only for teaching flexible material for retaining a garbage can lid. The Office Action cites no description or drawing in Ban that discloses or suggests a hatch with slots for holding a tool wherein the hatch is large enough to receive the entire tool. In fact, in claim 1, Ban claims a “small opening” designed to receive the handle of the paint applicator, the handle extending through the opening exteriorly of the container, thus confirming (as can be seen by the Figures of Ban) that only paint handles are capable of passing through the cover of Ban. Ban does not disclose a hatch as claimed in the present invention and Metzger does teach nor suggest a lid having a hatch with slots as claimed by claim 1 of the present invention, and, accordingly, Metzger cannot remedy the deficiencies of Ban with respect to failing to teach or suggest claim 1’s feature of a hatch.

Further, in the Office Action, the Examiner asserted that Ban does not disclose a flexible strap surrounding the lid, but that it would have been obvious to provide a flexible strap surrounding the Ban lid as taught by Metzger in order to tightly maintain the lid with the container. Applicant respectfully disagrees with this assertion because the combination of Ban with Metzger is *prima facie* improper because the Office Action has cited nothing that would supply a person of ordinary skill in the art with a motivation to combine the teachings of Ban with the teachings of Metzger. As stated by the Federal Circuit in *Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000), “[d]etermining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness.” (citing *Tec Air, Inc. v. Denso Mfg.*, 52 USPQ2d 1296, 1297-98 (Fed. Cir. 1999) (stating that the factual underpinnings of obviousness include whether a reference provides a motivation to combine its teachings with another)). Furthermore, as noted by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a

combination of references. (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.”)). In the present case, there is no motivation shown to combine the paint container of Ban with the trash can lid of Metzger. Not only is there no motivation to combine the references, Ban discloses a seal that teaches away from strap of Metzger (see column 2, lines 46-51 which discloses a cover with a flange for sealing the container). Because the Office Action has cited no portion of Ban that would supply a person of ordinary skill in the art with a motivation to combine the teachings of Ban with the teachings of Metzger, the combination is *prima facie* improper.

For the above reasons, claim 1 is patentable over the improper combination of Ban with Metzger.

Claims 2, 3, 6, 13, 22, and 26 depend directly or indirectly from independent claim 1, and, accordingly, include all of the patentable features of claim 1 as well as other patentable features. Therefore, claims 2, 3, 6, 13, 22, and 26 are patentable over the combination of Ban with Metzger for at least the reasons discussed above with respect to claim 1. The rejection of claims 20-21 and 23-25 has been rendered moot by the cancellation of these claims.

Claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,533,044 to Ban in view of U.S. Patent No. 5,295,508 to Metzger and further in view of U.S. Patent No. 6,041,919 to Adams. This rejection is respectfully traversed with respect to the claims as currently presented.

The Examiner asserts that Ban in view of Metzger does not disclose a flexible gasket underneath the hatch as claimed in claim 34, but that Adams teaches such a flexible gasket and, therefore, it would have been obvious to modify Ban with a gasket as taught by Adams. First, Applicant would like to reassert the arguments set forth above as to the insufficiency of the Ban reference alone and the improper combination of Ban and Metzger which should alone overcome this rejection also. Additionally, however, Applicant would

like to point out that the combination of Ban and Metzger with Adams is also *prima facie* improper because the Office Action has cited nothing that would supply a person of ordinary skill in the art with a motivation to combine the teachings of Ban and Metzger with the teachings of Adams. Not only is there no motivation to combine the references, Ban discloses an opening seal that teaches away from the gasket of Adams (see column 3, lines 3-15 which discloses a flexible seal wrapped in conical relation around the handle of a painting tool to hold the tool in place). Because the Office Action has cited no portion of Ban that would supply a person of ordinary skill in the art with a motivation to combine the teachings of Ban with the teachings of Adams, the combination is *prima facie* improper.

For the above reasons, claim 34 is patentable over the improper combination of Ban and Metzger with Adams.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Kimberly Snead at 703-563-2043.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,



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October 26, 2005